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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,561	10/28/2003	Michael J. Picciallo	P22,425-G USA	9169

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EXAMINER

SHAH, AMEE A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,561

Applicant(s)

MICHAEL PICCIALLO

Examiner

Amea A. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-17 are pending this action.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The prior application, number 08/585,173, from which this application claims benefit as a continuation-in-part, does not adequately support the claims. In particular, application number 08/585,173 does not disclose a computer-based method for transferring funds as there is no mention of a computer, as recited by claim 1. Therefore, priority goes back to application number 08/876,929, filed 06/16/1997.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information

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submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10, 11, 13 and 14 are rejected under 35 U.S.C. 102(e)(2) as being anticipated by Fleming (Patent No. 5,953,710).

Referring to claim 1. Fleming discloses a computer-based method for transferring funds from a bank or credit card account of a fund depositor to third party dependents (Figure 1 and col. 5, lines 30-31 – note that the computer is comprised of the processing systems), comprising:

- creating a bank or credit card account for debit or credit card access by a third party financially dependent upon a fund depositor, from which funds may be transferred at the request of said third party as a cash withdrawal or payment for goods or services purchased by said third party (col. 5, lines 40-62 and col. 12,

- line 56 through col. 13, line 15 – note that the creation of the account is the creation of the parent account with an established available credit for child's use and is inherently capable of being used for the purpose of creating access by the third party and from which funds may be transferred at the request of the third party for the purpose of cash withdrawal or payment for goods and services); and
- limiting the amount of funds in said bank or credit card account of said third party dependent that may be withdrawn as cash or spent on at least one class of goods or services in response to instructions from said fund depositor (col. 6, lines 30-32 and col. 13, lines 2-23 – note that the limiting of the amount of funds is the parent-determined child's credit limit and available credit).

Referring to claim 2. Fleming further discloses the method of claim 1, further comprising the step of periodically and automatically transferring funds into said third party account from said fund depositor account in response to command instructions from said fund depositor (col. 14, lines 55-60 – “[w]hen the parent selected allowances, they would be prompted by the Bank Telecom Interface to enter the allowance amount and the periodic interval of the allowance, such as weekly”).

Referring to claim 3. Fleming discloses the method of claim 1 comprising the further step of storing information on fund transferees and corresponding payment amounts for said third party account (col. 6, lines 4-24 – note the step of storing information is the inclusion of information in the data model which comprises databases); and supplying to said fund depositor

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through an output device said information on fund transferees and corresponding payment amounts for said third party account (Figure 2A and col. 7, lines 25-37 – note the supplying of information is the monthly statement).

Referring to claim 4. Fleming further discloses the method of claim 1, wherein said fund depositor account and said third party account are both in communication with an external bank, credit card or atm network (col. 5, lines 10-24 – note that the external network is the Merchant Credit Card Transaction Processing System).

Referring to claim 5. Fleming further discloses the method of claim 1, wherein said bank or credit card account for said fund depositor is established for the transfer of funds to said third party account (col. 5, lines 40-62 and col. 12, line 56 through col. 13, line 15 – note that the account is inherently capable of being established for the purpose of transferring funds to said third party account).

Referring to claims 6-7. Fleming discloses the method of claim 1 further comprising the step of verifying each transfer requested by said third party to determine whether the goods or services to be purchased are authorized (claim 6) and wherein said goods or services comprise books, computer software, food, lodging or entertainment (claim 7) (col. 8, lines 14-37 – note that the verification is the approval and is inherently capable of being performed for the purpose of determining whether the goods or services to be purchased are authorized, and that goods or

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services purchased are inherently capable of being comprised of books, computer software, food, lodging or entertainment).

Referring to claims 10-11. Fleming discloses the method of claim 3 wherein said information on fund transferees and corresponding payment amounts for said third party account is automatically supplied to said fund depositor (claim 10), and wherein said supplying step is performed periodically (claim 11) (Figure 2A and col. 7, lines 25-37 – note the statement is inherently automatically supplied and the period is monthly).

Referring to claim 13. Fleming further discloses the method of claim 2, wherein said funds are transferred weekly or monthly (col. 14, lines 55-60 – “[w]hen the parent selected allowances, they would be prompted by the Bank Telecom Interface to enter the allowance amount and the periodic interval of the allowance, such as weekly” - note that the periodic interval is inherently capable of being performed on a monthly basis as well as weekly).

Referring to claim 14. Fleming further discloses the method of claim 1 wherein said financially dependent third party is a son or daughter of said fund depositor (col. 3, lines 11-25 – note that son or daughter is included in child).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Fleming in view of Dethloff et al. (Patent No. 4,837,422).

Referring to claims 8 and 9. Fleming discloses the method of claim 1, as discussed supra, but does not disclose wherein said limit is a periodic limit on the amount that can be spent on at least one class of goods or services (claim 8) nor does Fleming disclose wherein the limit is a limit on the transactional amount (claim 9).

Dethloff et al. discloses a multi-user card system with restrictions for use by a sub-user to a desired extent with regard to value and time (*see* Abstract), including incorporating a periodic limit on the amount that can be spent on at least one class of goods or services (claim 8) (col. 7, lines 39-44 – note that the periodic limit is the assignation of the M-card for a day or number of days), and wherein the limit is a periodic limit on the amount that can be spent on at least one class of goods or services (claim 9) (col. 7, lines 38-46 – note that the limit on the transactional amount is the assignation of the M-card for one expected transaction and for limited amounts).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Fleming to include the teachings of Dethloff et al. to allow for the limit to be a periodic limit on the amount that can be spent on at least one class of goods or services or a limit on the transactional amount. Doing so would allow for parents to allow their children to obtain certain services while staying within the conditions and limitations of a fixed time period and amount, allowing the parents more control over the child's spending

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habits, greatly enhancing the comfort and convenience of parents, as suggested in Dethloff et al. (col. 6, lines 22-32).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming in view of Hilt et al. (Patent No. 5,465,206).

Referring to claim 12. Fleming discloses the method of claim 3, as discussed supra, but does not disclose wherein said information is supplied via email.

Hilt et al. discloses an electronic bill pay system wherein information is supplied via e-mail (col. 22, lines 41-45, “a message could be interchangeably embodied in a postal mail paper form, an e-mail message, a telephone voice response session, etc.” – note that a message includes information regarding transactions).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Fleming to include the teachings of Hilt et al. to allow for the information to be supplied via email. Doing so would result in a reduction of paper and increase in efficiency thereby resulting in increase in profits, as suggested by Hilt et al. (col. 6, lines 19-21 and col. 20, lines 22-25).

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming in view of Matsumoto et al., (Patent No. 6,345,263).

Referring to claims 15-16. Fleming discloses the method of claim 1, as discussed supra, but does not disclose wherein said limiting step comprises prohibiting any amount of funds to be

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withdrawn as cash or spent on at least one class of goods or services (claim 15), nor wherein the withdrawal of cash or spending on alcohol or tobacco is prohibited (claim 16).

Matsumoto et al. discloses an electronic purse system and method having an IC card for storing electronic money information and information for giving transaction conditions and restrictions (col. 1, lines 59-63), including limiting transactions to prohibit any amount of funds to be withdrawn as cash or spent on at least one class of goods or services, particularly alcohol or tobacco (col. 2, lines 6-39 – note that the prohibition on any amount of funds is the using of the age stored to prevent selling of alcoholic drink or cigarettes).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Fleming to include the teachings of Matsumoto et al. to allow for the limiting step to comprise prohibiting any amount of funds to be withdrawn as cash or spent on at least one class of goods or services, and wherein the withdrawal of cash or spending on alcohol or tobacco is prohibited. Doing so would allow for “appropriate use of electronic money automatically taking care of restrictions and conditions due to... age,” and “automatically prevent selling to a minor,” thereby providing a control mechanism to ensure money is spent properly and within the condition set forth by a parent or other fund depositor, as suggested in Matsumoto et al. (col. 1, lines 47-58).

Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming in view of Oncken et al. (Patent No. 4,725,719).

Referring to claim 17. Fleming discloses the method of claim 1, as discussed supra, but does not disclose wherein a class of goods or services that is limited is an individual payee.

Oncken et al. discloses a restricted purpose, commercial, monetary regulation method whereby a network is established between a business owner, acceptor of the restricted purpose card and a financial institution so that the business user is enabled to purchase only one specific product or service from the acceptor (*see* Abstract). Oncken et al. further discloses wherein a class of goods or services that is limited is an individual payee (col. 4, lines 19-27 – note that the individual payee is the employer-selected payee).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of Fleming to include the teachings of Oncken et al. to allow for wherein a class of goods or services that is limited is an individual payee. Doing so would result in parents allowing children to make purchases with the assurance that the children will use the funds allocated to them for the specific goods or services from the source, service-provider, bookstore, supermarket or restaurant, pre-approved by the parents and will minimize the risk of abuse of funds by the children, as suggested in Oncken et al. (col. 3, lines 15-22).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(1) Dorrough et al., Patent No. 5,287,269, disclosing an apparatus and method for accessing events, areas and activities through a card system (*see* columns 5-7 and 12-13); (2) Tannenbaum, Patent No. 5,326,960, disclosing a currency transfer system and method providing for the temporary establishment of a credit limit within an existing account (*see* columns 2-15); (3) Brody et al., Patent No. 5,350,906, disclosing a currency transfer system and method using

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fixed limit cards (*see* columns 2-15); (4) Pare, Jr. et al., Patent No. 5,870,723, disclosing a method and system for token-less authorization of commercial transactions between a buyer and seller using a computer system (*see* columns 4-8, 23-25, 38, and 53-56); (5) Hilt et al., Patent No. 6,032,133, disclosing a method for electronically paying bills (*see* columns 10-22); (6) Nagahara et al., EP 0725376 A2, disclosing a charging method and system adapted for use in interactive online services (*see* columns 1-9) and (7) Brooker, Dena, "Purchasing Cards: The Next Generation," Modern Publishing, Toronto, June 1997, volume 39, issue 6, page 18.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAS

May 16, 2005


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